

R E M A R K S

A. INTRODUCTION

Claims **1-23** are pending and rejected.

Upon entry of this Amendment:

- Claims **1-23** will be pending
- Claims **1, 22, and 23** will be the only independent claims

This amendment is responsive to the Non-final Office Action mailed on November 29, 2007 (hereinafter the "Office Action").

In view of the above amendment and the following remarks, Applicants respectfully request withdrawal of the current rejections and allowance of the application.

B. AMENDMENT TO THE SPECIFICATION

The specification has been amended to update the priority information. In particular, U.S. Patent Application No. 09/994,569 issued as U.S. Patent No. 6,597,770 on July 23, 2003 and the "Cross-Reference to Related Applications" section has been amended to reflect that fact. No new matter has been added.

C. THE DOUBLE PATENTING REJECTIONS

Claims **1-23** were rejected on the grounds of non-statutory obviousness-type double patenting as being unpatentable over claims 1-16 and 19-22 of U.S. Patent No. 6,597,770 (hereinafter "the '770 patent"). In addition, claims **1-23** were rejected and on the grounds of non-statutory obviousness-type double patenting as being unpatentable over claims 1-3, 5, 9-12, 14 and 18-19 of U.S. Patent No. 6,327,348 (hereinafter "the '348 patent").

Although Applicants do not necessarily agree with the double patenting rejection concerning the '770 patent, enclosed herewith is a Terminal Disclaimer with regard to the '770 patent, which is being filed to expedite the prosecution of the present application. In particular, the Terminal Disclaimer disclaims the terminal part of the statutory term of any patent granted

on the instant application that would extend beyond the expiration date of the commonly owned '770 patent. Thus, Applicants respectfully request withdrawal of this double-patenting rejection.

Applicants hereby respectfully traverse the double patenting rejection of claims **1-23** based on claims 1-3, 5, 9-12, 14 and 18-19 of the '348 patent.

Any analysis employed in an obviousness-type double patenting rejection parallels the guidelines for analysis of a 35 U.S.C. §103 obviousness determination. MPEP 804(II)(B)(1). Thus, the factual inquiries set forth in Graham v. John Deere that are applied for establishing a background for determining obviousness under 35 U.S.C. §103 are employed when making an obvious-type double patenting analysis. MPEP 804(II)(B)(1). When considering whether a claim of an application is an obvious variation of a claim of a patent, the disclosure of the patent may not be used as prior art. MPEP 804(II)(B)(1).

Applicants respectfully submit that the Examiner's finding of similar subject matter cannot support a determination of double patenting. In particular, claim 1 of the '348 patent is directed to a **system** for facilitating communication between first and second persons, and requires "means for linking the first and second persons to a financial account...", means for receiving data from a third party, means for inquiring whether the first person desires to communicate with the second person based on data identifying the financial account, means for receiving a response from the first person, and means for initiating communication between the first and second persons based on the response. In contrast, pending claim 1 recites **a method** that includes associating first and second persons with the same account, receiving a request to authorize a transaction between the second person and a third party, determining whether the first person desires to communicate with the second person, determining a communication address, and enabling communication based on the communication address if the first person desires to communicate. Furthermore, pending claim 1 does **not** include receiving data from the third party identifying the financial account and the third party, **nor** does it include initiating communication between the first and second persons based on the response, which are both required by claim 1 of the '348 patent. Not only are these limitations missing, pending claim 1 also requires *receiving a request to authorize a transaction between the second person and a third party*, and *determining at least one communication address*, which limitations are absent from claim 1 of the '348 patent. Accordingly, we submit that pending claim 1 and claim 1 of the

‘348 patent are patentably distinct from each other because they are of a different type **and** are of different scope. Furthermore, applicants respectfully submit that it would not have been obvious for one skilled in the art to modify claim 1 of the ‘348 patent to add the missing limitations. Thus, allowance of pending claim 1 would not result in an unjustified time-wise extension of the monopoly granted for the invention recited by claim 1 of the ‘348 patent.

Similarly, allowance of pending dependent claim 2 would not result in an unjustified time-wise extension of the monopoly granted for the invention recited by claim 1 of the ‘348 patent for at least the same reasons recited above. In addition, present claim 2 requires *receiving from the first person an indication that the first person desires to communicate with the second person*, which operation is different from that recited by claim 1 of the ‘348 patent. In particular, claim 1 requires “means for **inquiring** whether the first person desires to communicate with the second person based on the data identifying the account.” Thus, this double patenting rejection should be withdrawn.

Pending claim 3 is nothing at all like claim 3 of the ‘348 patent, which comparison was made by the Examiner (Office Action, page 6). In fact, pending claim 3 recites: *receiving a signal from the first person, the signal comprising an indication of whether to authorize the transaction; and processing the transaction based on the signal*. In stark contrast, claim 3 of the ‘348 patent recites: “wherein the signal indicates a personal ID number.” Accordingly, we submit that pending claim 3 is patentably distinct from claim 3 of the ‘348 patent, and assert that it would not have been obvious for one skilled in the art to modify claim 3 of the ‘348 patent to add the missing limitations recited by pending claim 3. Thus, allowance of pending claim 3 would not result in an unjustified time-wise extension of the monopoly granted for the invention recited by claim 3 of the ‘348 patent.

Applicants also submit that pending claim 4 is nothing at all like claim 10 of the ‘348 patent, which comparison was made by the Examiner (Office Action, page 6). In fact, pending claim 4 recites: *receiving a first signal from the first person, the first signal indicating whether to authorize the transaction; and transmitting a second signal to the third party, the second signal indicating whether the transaction is authorized*. In stark contrast, claim 10 of the ‘348 patent recites: “means for receiving a first signal for the first person, the first signal indicating whether to authorize a transaction between the second person and the third party; and means for transmitting a second signal to the third party if the first signal indications the transaction is to be

authorized, the second signal authorizing the transaction.” Accordingly, we submit that pending claim 4 is patentably distinct from claim 10 of the ‘348 patent, and assert that it would not have been obvious for one skilled in the art to modify claim 10 of the ‘348 patent to conform to the subject matter recited by pending claim 4. Thus, allowance of pending claim 4 would not result in an unjustified time-wise extension of the monopoly granted for the invention recited by claim 10 of the ‘348 patent.

With regard to dependent claims **5-17 and 19-21**, we respectfully submit that the double patenting rejection should be withdrawn for at least the same reasons recited above concerning pending claim 1. In particular, although the subject matter of these pending dependent claims may arguably be suggested by the claims of the ‘348 patent cited by the Examiner (Office Action, pages 6-8), when considered in conjunction with the subject matter of pending claim 1, Applicants respectfully submit that there would be no unjustified time-wise extension of the monopoly granted for the invention recited by the claims of the ‘348 patent. Thus, we respectfully request withdrawal of these rejections.

Dependent claim **18** recites *enabling text-based communication between the first person and the second person*. Applicants respectfully submit that claim 1 of the ‘348 patent, which were cited by the Examiner with regard to claim **18**, does not include such recitations, and is in fact silent with regard to the mode of communication between parties. Thus, allowance of present claim **18** would not provide an unjustified time-wise extension of the monopoly granted for the invention recited by claim 1 of the ‘348 patent.

Applicants respectfully submit that independent method claim **22** also is patentably distinct from the combination of claims 1 and 2 of the ‘348 patent, which combination was suggested by the Examiner (Office Action, page 8). In particular, **no** combination of claims 1 and 2 of the ‘348 patent recites *receiving a request to authorize a transaction between the second person and a third party*, nor *determining a first communication address that is associated with the first person based on the identifier that indentifies the financial account*, nor *establishing a connection to the first person based on the first communication address*, nor *determining a second communication address that is associated with the second person*; nor *enabling communications between the first person and the second person based on the second communication address*. Accordingly, pending claim **22** is patentably distinct from the combination of claims 1 and 2 of the ‘348 patent because they are of a different type **and** of

different scope, and we submit that it would not have been obvious for one skilled in the art to modify claims 1 and 2 of the '348 patent to add such missing limitations. Thus, allowance of pending claim **22** would not result in an unjustified time-wise extension of the monopoly granted for the invention recited by claims 1 and 2 of the '348 patent.

Applicants respectfully submit that independent method claim **23** also is patentably distinct from the combination of claims 1 and 2 of the '348, which combination was suggested by the Examiner. In particular, no combination of claims 1 and 2 of the '348 patent recites *receiving an indication of a transaction between **a user of a credit card account** and a merchant, in which **the transaction is associated with the credit card account***; nor *after receiving the indication of the transaction, enabling communication between the account holder and the user*; nor *receiving from the account holder an indication of whether to authorize the transaction as required by claim **23*** (emphasis added). In fact, the combination of claims 1 and 2 of the '348 patent fails to recite a credit card account, requires "linking" first and second persons to a financial account, and requires processing the transaction based on a signal from the first person. Thus, pending claim **23** is patentably distinct from the combination of claims 1 and 2 of the '348 patent because the cited claims are not only of a different type, but because the cited claims are of different scope. Consequently, it would not have been obvious for one skilled in the art to modify claims 1 and 2 of the '348 patent to add the missing limitations of pending claim **23**, and to specifically omit some of the limitations that are *required* by claims 1 and 2 of the '348 patent. Thus, allowance of pending claim **23** would not result in an unjustified time-wise extension of the monopoly granted for the invention recited by claims 1 and 2 of the '348 patent.

In summary, Applicants respectfully submit that none of the pending claims are identical in scope to the cited claims of the '348 patent. Furthermore, the Examiner has failed to identify and address the differences between the pending claims and the cited '348 claims, which is required in accordance with a proper obviousness analysis. Although the pending claims and the issued claims may overlap in scope with respect to some types of embodiments, that consideration alone is not enough to reject the pending claims for double patenting. In addition, no motivation to modify or combine teachings has been provided in support of the double patenting rejections. Lacking a motivation to modify the scope of the issued claims, there is no *prima facie* case of obviousness. In re Rouffet, 149 F.3d 1350, 1358 (Fed. Cir. 1998).

In view of the above remarks, we respectfully request reconsideration and withdrawal of the obviousness double patenting rejection of claims **1-23** with respect to the claims of the '348 patent.

D. SECTION 103(A) REJECTIONS

Claims **1-10, 12-21 and 23** were rejected under 35 U.S.C. 103(a) as being unpatentable over Bickham et al. U.S. Patent No. 5,530,438 (hereinafter "Bickham"), in view of Hird et al., U.S. Patent No. 5,319,701 (hereinafter "Hird").

Claim **22** was rejected as being unpatentable over Hird in view of Bickham.

Claim **11** was rejected as being unpatentable over Bickham in view of Hird and further in view of Cucinotta et al., U.S. Patent No. 6,081,792 (hereinafter "Cucinotta").

We respectfully traverse the Examiner's Section 103(a) rejections.

1. Brief Description of the Cited References

Bickham pertains to a method of providing, to a radio system user who is authorized to conduct financial transactions, an alert of a financial transaction of interest to that user. Identifying data of a customer seeking to engage in the financial transaction is obtained, and part of the identifying data is used to identify the radio system user. A message indicative of the financial transaction is automatically provided and broadcast by the system to the radio system user. In this manner the radio system user is alerted to the financial transaction, and the alert occurs at a time that enables the user to participate in the approval of the financial transaction if desired (see Bickham, col. 2, line 58 to col. 3, line 2).

Hird is directed to a telephone system and method that is interactive with a calling party and the called party, to automatically complete calls that would otherwise require the services of a line operator. Prompting messages stored locally in the telephone station are played for the calling party to prompt him in the proper steps to take to place a collect call. Charges for the collect call are calculated and stored at the telephone station for later billing to the called party (see Hird, col. 1, line 64 to col. 2, line 22).

Cucinotta pertains to a method of providing money, goods, or services to an account holder based on an amount, when the daily ATM (automatic teller machine) limit has been met, or when a debit card or credit card PIN (personal ID number) cannot be remembered. The process enables the account holder to access cash and/or items of value through either the ATM network or a POS (point-of-sale) network to obtain cash or the item (see Cucinotta, Abstract and col. 3, lines 23-32).

2. Independent Claims 1, 22 and 23 Are Patentably Distinct Over Bickham and Hird

Applicants respectfully submit that no combination of the subject matter of Bickham and Hird would have provided for the features of:

associating a first person with an account;

associating a second person with the account;

receiving a request to authorize a transaction between the second person and a third party;

as recited in claims **1 and 22**.

The Examiner asserts:

“Regarding claim 1, Bickham discloses, a method (col. 2, line 58) comprising: associating a first person with an account (col. 3, lines 66-67; the radio system user 126 has a financial transaction)

associating a second person with the account (col. 32, lines 39-40; the second person engages in this transaction account)

receiving a request to authorize a transaction between the second person and a third party (col. 4, lines 34-36).” [Office Action, pages 10-11].

Applicants respectfully disagree with the Examiner’s interpretation of Bickham as teaching or suggesting (1) associating a first person and a second person with the same account; and (2) receiving a request to authorize a transaction between the second person and the third party. In particular, Bickham is devoid of any teaching concerning associating persons with an account. The cited portions of Bickham merely recite that the radio user is authorized to conduct a financial transaction and possesses a radio (col. 3, lines 66-67), and that the customer seeking to engage in a transaction with a provider conveys identifying data to the provider (col. 3, lines

39-40). There is no mention of associating both the customer and the authorized person with a financial account. Furthermore, Bickham fails to teach or suggest *receiving a request to authorize a transaction* between the customer and the provider. The portion of Bickham that was cited as allegedly teaching such operation actually discloses that the radio user may broadcast a message to approve or disapprove the financial transaction (col. 4, lines 31-35). There is no indication whatsoever in Bickham that such a message was in response to any request from the goods or services provider. In particular, there is **no** mention in Bickham of such a provider requesting anything from the radio user. Instead, Bickham is concerned with **alerting** the radio user to the occurrence of a transaction by employing a radio system to broadcast an alert. In fact, Bickham teaches embodiments wherein the radio user need **not** respond to the alert (see, for example, col. 5, lines 43-48), and in fact cannot respond in some cases because the radio is a one-way device (only capable of receiving a broadcast; see col. 4, line 2). Thus, Bickham fails to teach or suggest at least the elements highlighted above, which elements are recited by both of independent claims **1 and 22**.

Moreover, the Examiner admits:

“Bickham does not disclose determining whether the first person desires to communicate with the second person, determining at least one communication address and enabling communication between the first person and the second person based on the at least one communication address if the first person desires to communicate with the second person.” (Office Action, page 11).

The Examiner contends that Hird provides the necessary teaching to make up for the above quoted deficiencies of Bickham. However, Hird pertains to methods and apparatus for performing an automated collect call, as explained above. Applicants respectfully submit that one skilled in the art would not combine the radio system user alerting method of Bickham with the automatic collect calling process of Hird without some teaching to do so, as these systems are in non-analogous fields. Furthermore, even if these references were combined, the result would not be the process as claimed. Instead, a process wherein a radio system user would receive a “collect call” communication from a customer would be the result, wherein the system would include a means to determine and bill the radio system user for the communication. Such a process is not claimed by either of present claims **1 or 22**.

Furthermore, the Examiner's purported motivation for one skilled in the art to combine these references, that it would be obvious "to modify Bickham (sic., Bickham's) method, to include a communication between the first and second party, as taught by Hird, in order to allow for additional verification for the transaction" is incongruous given the thrust of the process disclosed by Bickham, which is to notify the radio user of the occurrence of a transaction. In particular, there is no need for any "additional verification". Thus, Appellants respectfully submit that one of skill in the art would not have been motivated to review Hird in view of the radio system alerting method described in Bickham.

For at least these reasons, the Examiner has failed to establish a *prima facie* case of obviousness with respect to claims **1 and 22**. In addition, dependent claims **2-21** all directly or indirectly depend on claim 1, and thus these claims should be allowable for at least the same reasons. Accordingly, we respectfully request withdrawal of the Section 103(a) rejections of claims **1-22**.

Applicants note that claim **11** was separately rejected as unpatentable over Bickham in view of Hird and further in view of Cucinotta. But Cucinotta pertains to an ATM and POS terminal process, as described above, that enables an account holder to still obtain money or an item of value even if he forgets his PIN. Cucinotta was cited for disclosing use of an ATM, but we respectfully assert that Cucinotta does not cure the deficiencies of Bickham and Hird discussed above, and thus adds nothing that would render the combination of claims **11 and 1** obvious. Accordingly, we respectfully submit that dependent claim **11** is allowable for at least the same reasons set forth above.

3. Claim 23 is Patentably Distinct Over the Cited References

Independent claim **23** recites: *after receiving the indication of the transaction, enabling communication between the account holder and the user*. The Examiner admits that Bickham does not teach such operation (Office Action, page 16), but asserts that Hird does so. But applicants respectfully reassert that because Hird pertains to methods and apparatus for performing an automated collect call, one skilled in the art would not combine the radio system user alerting method of Bickham with the process of Hird. Yet further, even if these references were combined, the result would be a different process from that claimed; in particular, a process

would result wherein a radio system user receives a “collect call” from a customer, determines if he will take the collect call, and then pays a bill somehow calculated by the radio system. Such a process is very different from that claimed by claim **23**.

Thus, in view of the above remarks, Applicants respectfully request withdrawal of the Section 103(a) rejection of claim **23**.

E. ADDITIONAL COMMENTS

Our silence with respect to the Examiner’s other various assertions not explicitly addressed in this paper, including assertions of what the cited reference(s) teach or suggest, the Examiner’s interpretation of claimed subject matter or the Specification, or the propriety of any asserted combination(s) of teachings, is not to be understood as agreement with the Examiner. As the Examiner has not established an unrebuttable prima facie case for rejecting any of the claims as pending, for at least the reasons stated in this paper, we need not address all of the Examiner’s assertions at this time. Also, the absence of arguments for patentability other than those presented in this paper should not be construed as either a disclaimer of such arguments or as an indication that such arguments are not believed to be meritorious.

CONCLUSION

It is submitted that all of the claims **1-23** are in condition for allowance. Thus, the Examiner's early re-examination and reconsideration are respectfully requested.

If the Examiner has any questions regarding this Response or the present application, the Examiner is cordially requested to contact Stephan Filipek at telephone number (203) 461-7252 or via electronic mail at sfilipek@walkerdigital.com.

AUTHORIZATION TO CHARGE APPROPRIATE FEES

Applicants hereby petition for a one month extension of time to respond, and authorize the Commissioner to charge our Deposit Account No. 50-0271. Please also charge the fee for the Terminal Disclaimer submitted herewith to the same Deposit Account.

No other fees are believed to be due, but if a fee should be necessary to continue prosecution of the present application, please charge any such required fee to our Deposit Account No. 50-0271. In addition, please credit any overpayment to Deposit Account No. 50-0271.

Respectfully submitted,

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Date

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